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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,699	02/20/2004	Yves Claude Nicolau	54341-0211 (297751)	5622

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EXAMINER

VAKILI, ZOHREH

ART UNIT PAPER NUMBER

1614

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/783,699	<b>Applicant(s)</b> NICOLAU ET AL.	
	<b>Examiner</b> Zohreh Vakili	<b>Art Unit</b> 1614	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112, First Paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, because the specification does not reasonably provide enablement for small molecules breaking beta-sheet conformation in amyloid protein. The specification does not enable any person skilled in the art to which it pertains to make or use the invention commensurate in scope with these claims.

In this regard, the application disclosure and claims have been compared per the factors indicated in the decision *In re Wands*, 8 USPQ2nd 1400 (Fed. Cir. 1988)

As to undue experimentation.

The factors include:

- 1) the nature of the invention;
- 2) the breadth of the claims;
- 3) the predictability or unpredictability of the art;
- 4) the amount of direction or guidance presented;
- 5) the presence or absence of working examples;
- 6) the quantity of experimentation necessary;

Each factor is addressed below on the basis of comparison of the disclosure, the claims and the state of the art in the assessment of undue experimentation.

- 1) the nature of the invention; the invention is directed to a composition for breaking beta sheet conformation.

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- 2) the breadth of the claims; the scope of the method claims include small molecules for breaking of beta-sheet conformation in amyloid protein. Claims are very broad and encompass any small molecule for breaking of beta-sheet conformation in amyloid protein.
- 3) the predictability or unpredictability of the art; the art does not enable a person of ordinary skill in the art to make and use the claimed invention without resorting to undue experimentation. The relative of those skilled in the art is high the unpredictability of the pharmaceutical and chemical art is high.
- 4) the amount of direction or guidance presented; the specification and the example does not provide any guidance in terms of small molecules for breaking of beta-sheet conformation in amyloid protein.
- 5) the presence or absence of working examples; no working examples are provided for small molecules for breaking of beta-sheet conformation in amyloid protein, for example in a patient, in the specification. The applicant has not provided any competent evidence or disclosed any tests that are highly predictive for the preventative effects of the instant composition. Note that in cases involving physiological activity such as the instant case, "the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved". See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).
- 6) the quantity of experimentation necessary; the quantity of experimentation would be an undue burden to one of ordinary skill in the art and amount to the trial and error type of experimentation. Thus, factors such as "sufficient working examples", "the

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level of skill in the art" and "predictability", etc. have been demonstrated to be sufficiently lacking in the instant case for the instant composition claim. Since compound structure and activity for such pharmaceutical use must be determined from case to case by painstaking experimental study one of ordinary skill in the art would be burdened with undue experimentation to determine all compounds being capable for breaking of beta-sheet conformation in amyloid protein.

In consideration of each of factors 1-6, it is apparent that there is undue experimentation because of variability in prediction of outcome that is not addressed by the present application disclosure, examples, teaching and guidance presented. Absent factual data to the contrary, the amount and level of experimentation needed is undue.

**LACK OF WRITTEN DESCRIPTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH:**

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification discloses a composition comprising small molecules, which meet the written description and enablement provisions of 35 USC 112, first paragraph. However, claim 1 is directed to small molecules for breaking of beta-sheet conformation, which only corresponds in some undefined way to specifically instantly, disclosed chemicals. None of these small molecules, meet the written description provision of 35 USC § 112, first paragraph, due to lacking chemical structural

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information for what they are and chemical structures are highly variant and encompass a myriad of possibilities. The specification provides insufficient written description to support the genus encompassed by the claim.

Vas-Cath, Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that “applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the ‘written description’ inquiry, *whatever is now claimed*. (See page 1117). The specification does not “clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” (See Vas-Cath at page 1116).

With the exception of the above specifically disclosed chemical structures, the skilled artisan cannot envision the detailed chemical structure of the small molecules. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. The chemical structure itself is required. See Fiers v. Revel, 25 USPQ2d 1601, 1606 (CAFC 1993) Baird, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF’s were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence. Finally, University of California v. Eli Lilly and Co., 43 USPQ2d 1398, 1404, 1405 held that:

... To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that “the inventor invented the claimed invention.” *Lockwood v.*

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*American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (“[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.”). Thus, an applicant complies with the written description requirement “by describing the invention, with all its claimed limitations, not that which makes it obvious,” and by using “such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention.” *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966.

Therefore, only the above chemically structurally defined chemicals, but not the full breadth of the claim(s) meet the written description provision of 35 USC § 112, first paragraph. The species specifically disclosed are not representative of the genus because the genus is highly variant. Applicant is reminded that Vas-Cath makes clear that the written description provision of 35 USC § 112 is severable from its enablement provision. (See page 1115).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent; or

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- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 1, is rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Soto-Jara *et al.* (WO 2004/005336 A2) which teach the field of beta-sheet breaking peptides, particularly their use in the treatment of diseases such as Alzheimer's disease (see abstract). The peptides prevent the aggregation of beta-amyloid, and thereby prevent its cytotoxic effects. This approach has been suggested in Alzheimer's disease and in prion-related disorders and has lead to the beta-sheet breaking peptides (see page 3, lines 2-5).

### **Conclusion**

Rejection of claim1 is deemed proper.

No claim of the present application is allowed.

Any inquiry concerning this communication should be directed to Zohreh Vakili, telephone number 571-272-3099. The examiner can normally be reached from 8:30 a.m. to 6:00 p.m., Monday-Friday.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached at 571-272-0718. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.ouspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic business Center (EBC) at 866-217-9197 (toll-free).

Zohreh Vakili  
Patent Examiner  
Art Unit 1614

November 9, 2006

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*Ardin H. Marschel 11/12/06*  
ARDIN H. MARSCHEL  
SUPERVISORY PATENT EXAMINER